No. 310

IN THE

Supreme Court of the United States

OCTOBER TERM, 1943

SINCLAIR REFINING COMPANY,
Petitioner,

vs.

CONWAY P. COE, COMMISSIONER OF PATENTS,
Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA AND BRIEF IN SUPPORT THEREOF

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RAYMOND F. ADAMS,
LOUIS D. FORWARD,
of Counsel.

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PETITION FOR WRIT OF CERTIORARI

To the Honorable, The Chief Justice and the Associated Justices of the Supreme Court of the United States:

Your petitioner, Sinclair Refining Company, prays that a writ of certiorari issue to review the decree of the United States Court of Appeals for the District of Columbia entered herein on May 1, 1944 (R. 499).

A certified transcript of the record in the case, including the proceedings in the Court of Appeals, is furnished herewith in compliance with Rule 38 of this Court.

Summary Statement of the Matter Involved

This is a suit in equity brought by petitioner against the Commissioner of Patents in the United States District Court for the District of Columbia pursuant to the provisions of Section 4915, R. S. (35 U. S. C., Sec. 63) as

amended by Act of March 2, 1927, for an order authorizing and directing the Commissioner of Patents to issue to petitioner a patent for improvements in Oil Cracking Processes, as defined in certain claims in applications for letters patent duly filed in the United States Patent Office and assigned to petitioner. The claims in question were rejected by the Patent Office on definitely stated grounds and the grant of a patent containing such claims was refused.

The above mentioned statute gives the applicant whose patent has been so refused a right of action against the Commissioner of Patents. In such action the Commissioner of Patents, through the Solicitor for the Patent Office, sets up in its Answer to the complaint his reasons for refusing the grant of the patent, and the issues so defined are tried before the Court.

In the case at bar the answer of the Patent Office (R. 8) asserted that the disputed claims were not patentable to petitioner because of certain interference proceedings in the Patent Office decided, in part, adversely to petitioner. The District Court for the District of Columbia concluded that the Commissioner's grounds for refusing the patent sought by petitioner were sound and dismissed the complaint, and, in accordance with the practice of the District Court the Judgment of Dismissal was accompanied by Findings of Fact and Conclusions of Law (R. 10-12) wherein the issues presented by the pleadings were specifically ruled upon.

The claims were not refused by the Patent Office on the ground that they were unpatentable over the prior art. The answer of the Commissioner of Patents in this action contained no such allegation and no finding of fact to that effect was included in the Findings of the District Judge in support of the Judgment of Dismissal.

On appeal to the Court of Appeals for the District of Columbia the Judgment of Dismissal was affirmed, *but no*

ruling was made by the Court of Appeals on the issues presented for review by the Findings of the Lower Court, the sole ground of affirmance being the conclusion reached by the Court on its own motion that the claims were unpatentable over the prior art (R. 498).

The interferences referred to in the Answer of the Commissioner of Patents were declared before the *ex parte* prosecution of the application of petitioner's assignor Herthel was concluded, and, in accordance with the usual practice the *ex parte* prosecution of the application was suspended pending the outcome of the interference. The interferences were decided partly in favor of this applicant and partly in favor of the opposing party, Jenkins, whose application as originally filed appears in the record, pages 79 to 100, inclusive. After the conclusion of the interferences the Herthel application was remanded to the Primary Examiner for continuance of the *ex parte* prosecution. During the course of the *ex parte* prosecution applicant presented certain additional claims, including *inter alia*, the claims here in dispute. Some of the additional claims were allowed but the claims in dispute were rejected on the ground that they related to subject matter disclosed in the application of the adverse party in the interference proceeding.

It is the well established and universally applied rule of the Patent Office in the *ex parte* prosecution of an application after the termination of an interference, to refuse any claim which could have been based on the application of the other interfering party as originally filed and which could therefore have been included in the interference. Your petitioner contended that the claims here in dispute had no foundation in the application of the other party to the interference, but the Patent Office held otherwise and rejected the claims on that ground.

No question of the patentability of the claims over the prior art was raised by the Patent Office. The disputed

claims are obviously more limited than the issues of the interference and the patentability of the interference issues over the prior art was fully considered, both before and during the interference proceedings. Petitioner's position is that the disputed claims are not only *more* limited than the issues of the interference proceedings, but are so limited as to *exclude altogether* the disclosure of the Jenkins application. The Patent Office does not deny that the disputed claims are more limited than the issues of the interference which have been found patentable over the prior art, but *does contend* that the claims are *not sufficiently limited to fully exclude the Jenkins application*, and that petitioner is therefore barred by the interference proceedings from making such claims.

As stated above, this was the sole ground of rejection asserted by the Patent Office and is the sole ground for the dismissal of petitioner's complaint recited in the Findings of the lower Court. The Court of Appeals for the District of Columbia apparently gave no consideration whatsoever to the relation of the disputed claims to the Jenkins application, but has affirmed the judgment of the lower Court on an issue projected into the case of its own motion.

The Questions Presented

(1) May the Court of Appeals for the District of Columbia, in an appeal from an adverse decision in an action against the Commissioner of Patents under Section 4915 R. S. dispose of the appeal by holding the claims in dispute unpatentable over the prior art, when that question was not in issue and was not decided by the Court below?

(2) Does the public interest in the scope and validity of patents justify the Court of Appeals in ruling of its own motion on the patentability of the disputed claims

over the prior art in an action where the Commissioner of Patents *is the sole respondent* and does not raise the issue?

Reasons Why the Writ Should be Granted

(1) The action of the Court of Appeals for the District of Columbia in deciding this case *solely* on grounds not decided by the lower Court is contrary to established procedure and such action has been repeatedly condemned by this Court.

The grant of this petition will give to petitioner the review of the decision of the lower Court to which it is entitled, and which has been denied by the action of the Court of Appeals of the District of Columbia.

> *LeTulle* v. *Scofield, Collector of Internal Revenue*, 308 U. S. 415, 416:
>
> We took this case because the petition for certiorari alleged that the Circuit Court of Appeals had based its decision on a point not presented or argued by the litigants, which the petitioner had never had an opportunity to meet by the production of evidence.

See also:

> *Luther and Moore Lumber Co.* v. *Knight*, 217 U. S. 257, 265;
> *General Utilities Co.* v. *Helvering*, 296 U. S. 200;
> *Hormel* v. *Helvering*, 312 U. S. 552.

(2) The consideration of the question of patentability over the prior art of its own motion by an appellate court on an appeal where such a question is not presented is *justified only in exceptional cases to protect the public interest.* In a case where the Commissioner of Patents is the sole defendant, the public interest requires no further protection. If the decision of the Court of Appeals of the District of Columbia be allowed to stand, every

appellant, whatever the issue in the Patent Office—whether sufficiency of disclosure, new matter, public use, or what not—will have to present in its appeal a complete record on the question of patentability over the prior art even though that question be already decided in its favor in the Patent Office.

WHEREFORE it is respectfully submitted that this petition for a writ of certiorari to the Court of Appeals for the District of Columbia should be granted.

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Dated: New York, N. Y.,
July 26, 1944